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09/672,028	09/29/2000	Toshikatsu Tsukamoto	32739M037	2581

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Beveridge DeGrandi Weilacher & Young LLP
Suite 800
1850 M Street NW
Washington, DC 20036

EXAMINER	
PARK, CHAN S	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 03/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/672,028	TSUKAMOTO, TOSHIKATSU	
	Examiner	Art Unit	
	CHAN S PARK	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 9/29/04.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-4 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-4 is/are rejected.

7)☒ Claim(s) 1 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: "and" should be omitted in line 16. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morisawa et al. U.S. Patent No. 5,881,214 (hereinafter Morisawa).

1. With respect to claim 1, the Morisawa reference discloses an image output apparatus, comprising:

an image reading section for (image reading unit 25 in fig. 11) reading an image on a document and converting the image into image data (col. 7, lines 18-42);

an image storing section (optical magnetic disk storage unit 21) for storing the image data read by the image reading section;

an image output section (image printing unit 27) for outputting the image corresponding to the document on the basis of the image data stored in the image storing section (col. 6, lines 33-36);

an index recognizing circuit (CPU 11 in conjunction with RAM 300 in col. 2, lines 63-64) for image-recognizing, when an index sheet (marking sheet 400) carrying index information (index images 404 in conjunction with bar codes 403-405 in figs. 5 & 6) is read by said image reading section, the index information on the index sheet (col. 6, lines 5-11 & col. 9, lines 61-65);

an index registering circuit for registering the index information recognized by the index recognizing circuit and corresponding storage area designation information for designating a storage area in said image storing section, associated with each other (col. 5, line 9-46); and

a circuit for storing an image data representing a document which has been read by said image reading section subsequently to an index sheet in a storage area, in said image storing section, to be designated by a storage area designation information associated with said index information (col. 6, lines 5-11 & col. 7, line 55 – col. 8, line 57).

Additionally, it is apparent that the data recorded on the marking sheet 400 and an area where the document is stored are intended to correspond to each other (col. 8, lines 16-17 & col. 9, lines 61-65)

2. With respect to claim 4, the Morisawa reference discloses the image output apparatus according to claim 1, further comprising

an index sheet issue instruction accepting section (keyboard 15) for accepting an instruction to issue the index sheet, and

an index sheet output control circuit (image printing unit 27) for outputting the index sheet to said image output section in response to the acceptance of the instruction to issue the index sheet by the index sheet issue instruction accepting section (fig. 7 & col. 6, lines 12-37).

Note that accepting a marking sheet generating instruction from the keyboard is inherent since the user is given with various options to design the marking sheet (col. 5, line 9 – col. 6, line 11).

Claim Rejections - 35 USC § 103

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morisawa (hereinafter reference 1) as applied to claim 1 above, and further in view of Morisawa U.S. Patent No. 5,933,548 (hereinafter reference 2).

3. With respect to claim 2, reference 1 discloses the image output apparatus according to claim 1, but it does not disclose expressly a circuit for overwriting.

Reference 2, the same field of endeavor of marking sheet in the image output apparatus, discloses a circuit for overwriting, when the index information recognized by said index recognizing circuit has already been registered by said index registering circuit, an image data representing a document which has been read by said image reading section subsequently to the index sheet on the storage area, in said image storing section which is to be designated by the storage area designation information associated with the index information (col. 8, lines 7-17).

Further, overwriting newly obtained data to an already occupied memory space is a well-known method in memory management art.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the overwriting or updating method taught by reference 2 to the method of storing a plurality of print data in designated memory area of reference 1.

The suggestion/motivation for doing so would have been to efficiently update the newly obtained print data in the same memory area.

Therefore, it would have been obvious to combine two references to obtain the invention as specified in claim 2.

4. With respect to claim 3, reference 1 discloses the image output apparatus according to claim 1, but it does not disclose expressly an index image output instruction accepting section for accepting an index image output instruction for outputting a document image corresponding to an index information carried on an index sheet, and an index image output control circuit for reading out, when said index recognizing circuit recognizes the index information in a state where the index image output instruction is accepted by the index image output instruction accepting section, the image data, in said image storing section, to be designated by the storage area designation information associated with the recognized index information, and causing the image output section to output the image corresponding to the image data.

Reference 2, the same field of endeavor of marking sheet in the image output apparatus, discloses an index image output instruction accepting section for accepting

an index image output instruction for outputting a document image corresponding to an index information carried on an index sheet, and an index image output control circuit for reading out, when said index recognizing circuit recognizes the index information in a state where the index image output instruction is accepted by the index image output instruction accepting section, the image data, in said image storing section, to be designated by the storage area designation information associated with the recognized index information, and causing the image output section to output the image corresponding to the image data (col. 8, lines 53-62).

The cited column teaches that an analysis program for the group index registration gets an output instruction for printing out the stored image data.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the printing method taught by reference 2 with the method of storing a plurality of print data in designated or registered memory area of reference 1.

The suggestion/motivation for doing so would have been to efficiently print out the image data that are previously stored under the index sheet.

Therefore, it would have been obvious to combine two references to obtain the invention as specified in claim 3.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
March 18, 2004

EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600